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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,168	08/09/2001	Charles E. Slone	Slone.C-05	5323

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EXAMINER

WILSON, JOHN J

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 04/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,168

Applicant(s)

SLONE, CHARLES E. *CS*

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trushkowsky (6186786). Trushkowsky shows a handle 10, utility element 12, light receiving top surface as shown, downwardly converging cone shaped body 23, Fig. 5, and an integral work piece 24 having a downwardly directed curved portion as shown. The work piece defines an axis at an angle with respect to the handle axis as shown in Fig. 7. The specific angle used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to gain access to hard to reach places within the mouth. To use the shown structure with a matrix is an obvious matter of choice in the intended use of a known structure to the skilled artisan. As to claim 13, Trushkowsky shows a hyperbolic surface at 25.

Claims 5-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trushkowsky (6186786) in view of Maitland (4696646). Trushkowsky shows a handle 10, utility element 12, light receiving top surface as shown, downwardly converging cone shaped body 23, Fig. 5, and an integral work piece 24 having a downwardly directed curved portion as shown. The work piece defines an axis at an

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angle with respect to the handle axis as shown in Fig. 7. The specific angle used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to gain access to hard to reach places within the mouth. Trushkowsky does not show a flat surface. Maitland shows a flat surface at 1. It would be obvious to one of ordinary skill in the art to modify Trushkowsky to include the shape shown by Maitland in order to better distribute light in use.

Claims 1-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maitland (4696646). Maitland shows a light concentrating apparatus with an elongated handle 10, Fig. 9, light transmissive element 1 at the end of the handle and having an outwardly facing light receiving top surface 4, Figs. 1 and 4, and a downwardly converging curved shaped body 2 terminating in an integral end 5 that is downwardly curved as shown and defines an axis that is at an angle with respect to the longitudinal axis of the handle as shown in Fig. 9. The specific angle is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art. The light transmissive element has a generally curved shape as shown. The specific shape is an obvious matter of choice in the shape of a known element to the skilled artisan. To call end 5 a work piece is an obvious matter of choice in terminology and/or the intended use of a known structure. As to claim 3, see receiving surface on the inside of the arms of handle 10 as shown and the insertion surface on the side of element 4. As to claim 4, the specific shape of the surfaces used is an obvious matter

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of choice in the shape of a known element to one of ordinary skill in the art. As to claim 5, see flat surface as shown in Fig. 3.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims lack proper antecedent basis within the claims because they refer to a two ended embodiment, however, depend from claim 7.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 10, 11 and 13 of U.S. Patent

No. 6,280,187. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not include a positioning means is an obvious matter of choice in not using an element to one of ordinary skill in the art. The specific range of angles of the elements is an obvious matter of choice in the shape of a known structure to the skilled artisan. To include tools at both ends is an obvious matter of choice in the duplication of a known structure to one of ordinary skill in the art.

### ***Affidavits***

The affidavits filed April 8, 2003 under 35 C.F.R. 1.131 do not overcome the reference to Trushkowsky (6,186,786) because drawings and a general description of an invention are not sufficient to be a reduction to practice. These elements do establish conception of the invention and applicant's filing date establishes a reduction to practice, however, applicant must also show due diligence in the form of evidence from conception to the reduction of practice, see 35 C.F.R. 1.131 (b).

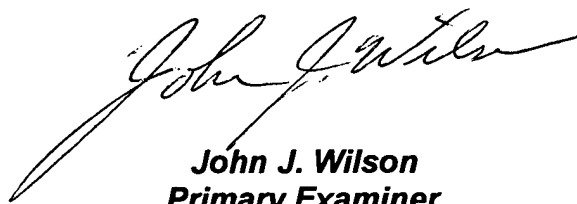
### ***Response to Remarks***

Applicant's remarks filed April 8, 2003 have been considered, however, are not deemed to be persuasive. The original rejection under 35 U.S.C. 112, second paragraph, has been withdrawn, however, a new rejection has been made, see above. Applicant's remarks with respect to the filed affidavits are properly responded to above.

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***Conclusi n***

Any inquiry concerning this communication should be directed to John  
Wilson at telephone number (703) 308-2699.

A handwritten signature in cursive script, appearing to read "John J. Wilson".

**John J. Wilson  
Primary Examiner  
Art Unit 3732**

jjw

April 25, 2003

Fax (703) 308-2708

Work Schedule: Monday through Friday, Flex Time